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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/783,610	02/19/2004	Vladek Kasperchik	10004809-1	1622

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INTELLECTUAL PROPERTY ADMINISTRATION  
FORT COLLINS, CO 80527-2400

EXAMINER
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SHEWAREGED, BETELHEM

ART UNIT	PAPER NUMBER
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1794

NOTIFICATION DATE	DELIVERY MODE
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06/11/2009

ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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<b>Office Action Summary</b>	<b>Application No.</b> 10/783,610	<b>Applicant(s)</b> KASPERCHIK ET AL.	
	<b>Examiner</b> Betelhem Shewareged	<b>Art Unit</b> 1794	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 24 February 2009.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-5 and 7-49 is/are pending in the application.
- 4a) Of the above claim(s) 15-35 is/are withdrawn from consideration.
- 5) ☐ Claim(s) 36-48 is/are allowed.
- 6) ☒ Claim(s) 1-5, 7-14 and 49 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>2/24/2009</u> .   | 6) <input type="checkbox"/> Other: _____                          |

### **DETAILED ACTION**

1. Applicant's response filed on 02/24/2009 has been fully considered. Claim 6 is canceled, and claims 1-5 and 7-49 are pending. Currently, claims 15-35 are withdrawn from consideration as non-elected invention.

### ***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-5, 7-13 and 49 are rejected under 35 U.S.C. 103(a) as being unpatentable over Otaki et al. (US 6,849,149 B2) in view of Coates (US 4,893,887) and Segel (US 4,378,392).

4. Otaki teaches a laminate comprising a transparent protective layer 206, a hologram 201, a transparent adhesive 205b, a recorded information 202, and a transparent film 203, in the order thereof (Fig. 10 and col. 26, line 47 thru col. 37, line 63). The transparent protective layer 206 meets the claimed protective layer, the hologram 201 meets the claimed metallic layer, the transparent adhesive 205b meets the claimed adhesive layer, and the transparent film 203 and the information 202 meet the claimed printable layer. The transparent film can be made of polyethylene terephthalate or polyethylene (col. 34, line 30 and col. 32, line 46). In order to improve the writing quality, a writing layer formed by coating a coating composition with fine

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particles, such as silica, being incorporated therein is provided on the transparent film (col. 34, lines 53-57). The writing layer meets the claimed ink receiving layer. The transparent protective film is made of acrylic (col. 32, line 46), and has a thickness of 10-100  $\mu\text{m}$  (col. 32, line 43). Otaki does not teach having a light stabilizer additive in any of the layers. However, Segel teaches a laminate including an adhesive layer (Fig. 1, col. 4, line 45), wherein the adhesive layer comprises UV light stabilizers (col. 6, line 7). Otaki and Segel are analogous art because they are from similar problem solving area in relation to adhesives. At the time of the invention it would have been obvious to a person of ordinary skill in the art to combine the UV stabilizer containing adhesive layer of Segel with the invention of Otaki, and the motivation would be, as Segel suggests, controlling the UV light stabilizing property of the layer (col. 6, line 6).

5. Otaki does not teach a metal hologram. However, Coates teaches a metal hologram having a thickness of 0.02 to 0.1  $\mu\text{m}$  (col. 2, line 42). Coates does not teach adding a colorant to the metal hologram. However, Official Notice is taken because changing the color of an article by adding a colorant is a common knowledge. At the time of the invention it would have been obvious to a person of ordinary skill in the art to control/change the color of the metal hologram by adding the desired colorant. Otaki and Coates are analogous art because they are from the same field of endeavor that is the hologram laminate art. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine the metal hologram of Coates with the invention of Otaki in order to provide a reflective and durable hologram.

***Response to Arguments***

6. Applicant's argument is based on that Segel does not teach or suggest a printable layer including an ink receiving layer as required by claim 1. The layer taught by Segel is not configured to be printed upon, is printless, and does not comprise an ink receiving layer. Segel expressly teaches that the characteristics required for the adhesive portion of the laminate include that "it be transparent". This argument is not persuasive for the following reason. The reference of Segel is not used to teach the claimed printed printable layer, it is used to teach the claimed adhesive layer having additives.

7. Applicant further argued that neither Otaki nor Segel, nor the combination thereof, teaches "a printable layer including an ink-receiving layer", "the printable layer including an additive configured for one of light stabilization, liquid resistance, or vapor resistance". This argument is not persuasive for the following reason. The claimed "printable layer including an ink-receiving layer" is taught by Otaki (see col. 26, lines 50 and 51, and col. 34, lines 53-57). Otaki, Segel or the combination thereof are not required to teach "the printable layer including an additive configured for one of light stabilization, liquid resistance, or vapor resistance" because the claimed invention is not limited to this limitation. The additive in the claimed invention can be contained in any of the layers, not only the printable layer. The Examiner introduced the teaching of Segel to teach the claimed adhesive layer containing the additive.

For the above reasons claims 1-5, 7-13 and 49 stand rejected.

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8. Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Otaki et al. (US 6,849,149 B2) in view of Coates (US 4,893,887).

9. Otaki teaches a laminate comprising a transparent protective layer 206, a hologram 201, a transparent adhesive 205b, a recorded information 202, and a transparent film 203, in the order thereof (Fig. 10 and col. 26, line 47 thru col. 37, line 63). The transparent protective layer 206 meets the claimed protective layer, the hologram 201 meets the claimed metallic layer, the transparent adhesive 205b meets the claimed adhesive layer, and the transparent film 203 and the information 202 meet the claimed printable layer. The transparent film can be made of polyethylene terephthalate or polyethylene (col. 34, line 30 and col. 32, line 46). In order to improve the writing quality, a writing layer formed by coating a coating composition with fine particles, such as silica, being incorporated therein is provided on the transparent film (col. 34, lines 53-57). The writing layer meets the claimed ink receiving layer. The transparent protective film is made of acrylic (col. 32, line 46), and has a thickness of 10-100 um (col. 32, line 43). Otaki does not teach a metal hologram. However, Coates teaches a metal hologram having a thickness of 0.02 to 0.1um (col. 2, line 42). Coates does not teach adding a colorant to the metal hologram. However, Official Notice is taken that changing the color of an article by adding a colorant is a common knowledge. At the time of the invention it would have been obvious to a person of ordinary skill in the art to control/change the color of the metal hologram by adding the desired colorant. Otaki and Coates are analogous art because they are from the same field of endeavor that is the hologram laminate art. At the time of the invention, it would have been

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obvious to a person of ordinary skill in the art to combine the metal hologram of Coates with the invention of Otaki in order to provide a reflective and durable hologram.

### ***Response to Arguments***

10. Applicant's argument is based on that neither Otaki nor Coates teach a metallic foil. A metallic foil, as commonly known, is an independent, thin sheet of self-supporting metal that is separate and distinct from the other layers (Application page 7, lines 17-18). Claim 14 specifically claims a metallic foil. Foils should not be confused with metallic layers that are deposited on substrates, and which are not independent or self-supporting. This argument is not persuasive for the following reasons. Even though the metal hologram of Coates is provided via sputtering and vacuum depositing, there is nothing that suggests the layer is not self-supporting after it has been formed. The type of metal is substantially identical to the type of metal of the claimed invention, and the thickness of the metal hologram is within the thickness of the claimed invention; therefore, the reference provides enough evidence to conclude that after the metal hologram of Coates is formed, a metal foil would be created. Furthermore, the claimed metallic foil is not the only part of the claimed composite material; it is one part of the claimed composite material. In addition, a metallic foil can be formed by sputtering or any other deposition method (see [0069] of Pritchett et al. (US 2002/0015292 A1), [0065] of Shima et al. (US 2002/0004134 A1) and [0039] of Koskenmaki et al. (US 2001/0020636 A1)).

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11. Applicant further argued that the methods of Coates, such as vacuum metallization, sputtering and vacuum depositing the thin layer of metal, would not create a foil (col. 2, lines 6-7, 15-17, and 27-29). This argument is not persuasive because it is based on a process limitation while the claimed invention is directed to an article; and the process by the metal layer/foil is formed is not dispositive of the issue of the patentability of the instant article claims.

12. Applicant also argued that the metal layer of Coates is always formed and mounted on a substrate, and it is evidence that it is not independent from the substrate and is also evidence that it is either too thin or not cohesive enough to support itself, and thereby does not qualify as a metallic foil. This argument is not persuasive because the argument drawn to a process limitation. The claimed metallic foil is inseparable part of the claimed composite material. In view of the claimed invention, the claimed composite material cannot be interpreted as a composite material having only the metallic foil. The claimed metallic foil is one of the three layers of the claimed composite material. The combination of Otaki and Coates teaches all the claimed layers including the claimed metallic layer/foil. However, the process the metallic layer/foil is formed in the composite material relates to a process limitation.

For the above reasons claim 14 stands rejected.

***Allowable Subject Matter***

13. Claims 36-48 are allowed. Otaki, Coates and/or Segel do not teach or suggest image free metallic layer.

***Conclusion***

14. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

15. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Betelhem Shewareged whose telephone number is (571)272-1529. The examiner can normally be reached on Monday-Friday 7am-4:30pm.

17. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kevin Bernatz, acting SPE for Carol Chaney can be reached on 571-272-1505. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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18. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

BS

June 7, 2009.

/Betelhem Shewareged/  
Primary Examiner, Art Unit 1794